

REMARKS

Applicants thank the Examiner for the thorough examination given the present application.

Status of the Claims

Claims 6-11 are pending in the present application. Claim 6 is amended by incorporating the subject matter of claim 12. As such, claim 12 is cancelled herein. Thus, no new matter has been added.

Applicants note that the Examiner did not consider claim 12 in the outstanding Office Action. Applicants' Representative contacted the Examiner on June 25, 2009 to bring this issue to the Examiner's attention. The Examiner recommended that Applicants note in the Response that the finality of the Office Action is not appropriate since claim 12 was not addressed. As such, the outstanding Office Action should be considered non-final. Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Issues under 35 U.S.C. § 103(a)

Claims 6-11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kajiwara et al. '431 (US 2002/0111431). Applicants respectfully traverse the rejection. Reconsideration and withdrawal of the outstanding rejection are respectfully requested.

Legal Standard for Determining Prima Facie Obviousness

MPEP 2141 sets forth the guidelines in determining obviousness. First, the Examiner has to take into account the factual inquiries set forth in *Graham v. John Deere*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), which has provided the controlling framework for an obviousness analysis. The four *Graham* factors are:

- (a) determining the scope and content of the prior art;
- (b) ascertaining the differences between the prior art and the claims in issue;

- (c) resolving the level of ordinary skill in the pertinent art; and
- (d) evaluating any evidence of secondary considerations.

Graham v. John Deere, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966).

Second, the Examiner has to provide some rationale for determining obviousness. MPEP 2143 sets forth some rationales that were established in the recent decision of *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007).

As the MPEP directs, all claim limitations must be considered in view of the cited prior art in order to establish a *prima facie* case of obviousness. See MPEP 2143.03.

Distinctions over the Cited Reference

As amended, claim 6 recites that “the content of methyl ethyl ketone-insoluble components in the copolymer is from 75% to 95% by weight.” By having the methyl ethyl ketone-insoluble components of the above-mentioned range, the present invention attains the advantageous effect of obtaining a dip-molded product excellent in resistance to organic solvents and in contact-state-sustaining performance.

In stark contrast, the latex of Kajiwara et al. ‘431 has a content of methyl ethyl ketone-insoluble components of 10 to 70% by weight (paragraph [0075]). In other words, Kajiwara et al. ‘431 fail to disclose that “the content of methyl ethyl ketone-insoluble components in the copolymer is from 75% to 95% by weight.” Further, Kajiwara et al. ‘431 state, “If the gel content is too high, the molded product becomes too stiff and the feeling to the skin is deteriorated” (paragraph [0075]). Thus, Kajiwara et al. ‘431 would actually teach away from the present invention as recited in claim 6.

To establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be disclosed by the cited references. As discussed above, Kajiwara et al. ‘431 fail to disclose all the claim limitations of independent claim 6, and those claims dependent thereon. Accordingly, Kajiwara et al. ‘431 do not render the present invention obvious.

Furthermore, the cited reference or the knowledge in the art provides no reason or rationale that would allow one of ordinary skill in the art to arrive at the present invention as claimed. Therefore, a *prima facie* case of obviousness has not been established, and withdrawal of the outstanding rejection is respectfully requested. Any contentions of the USPTO to the contrary must be reconsidered at present.

CONCLUSION

A full and complete response has been made to all issues as cited in the Office Action. Applicants respectfully request that a timely Notice of Allowance issue for the present case.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Chad M. Rink (Reg. No. 58,258) at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

By 

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